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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

DEXTER, C

ART UNIT

PAPER NUMBER

3724

27

DATE MAILED:

04/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/659,046

Applicant(s)
Bauer et al.

Examiner
Clark F. Dexter

Group Art Unit
3724



☒ Responsive to communication(s) filed on Feb 1, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 13, 14, and 17 is/are pending in the application.

Of the above, claim(s) 13 and 14 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 17 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 3724

DETAILED ACTION

1. The amendment filed February 1, 2000 has been entered.

Claim Rejections - 35 USC § 112

2. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In line 1, the characterization of the claimed invention as “[A] device” renders the claimed subject matter vague and indefinite, particularly since it is not clear how the disclosed components (i.e., the first and second hand-held tools as claimed) comprise a single hand device when they appear to be separate tools that are being used together to perform a particular function.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3724

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 17 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mende.

Mende discloses a hand tool with every structural limitation of the claimed invention including a disc (e.g., 5) having opposing edges (generally formed by a 90 degree intersection of two surfaces in the same manner as the present invention) formed by slot (e.g., 4) of fixed dimensions which slot narrows toward the center of the disc (e.g., it narrows at the bottom portion of the slot), and having a handle (e.g., 3).

In the alternative, if it is argued that two of the tools are not disclosed, the Examiner takes Official notice that it is old and well known in the art to provide as many tools as necessary to perform a desired task or tasks. For example, it would have been obvious to one having ordinary skill in the art to provide two of Mende's tools for various reasons including (1) having a second one as a backup in case a first one breaks or is lost, or (2) having a second one to provide to other users for performing other tasks. It is noted that the recitations directed to how the tools are used

Art Unit: 3724

together (e.g., "said sides directly touching each other at said edges") has been given little patentable weight since it is clearly an intended use of the disclosed tools.

Response to Arguments

6. Applicant's arguments filed February 1, 2000 have been fully considered but they are not persuasive.

In the third and fourth paragraphs on page 3 of the amendment, applicant argues that Pelosi, Jr. et al. is not prior art. Regarding the rejection under 35 USC 102(b), the Examiner intended to apply a prior art rejection under 35 USC 102(e) since it is clear that "102(b)" does not apply. Regarding a rejection under 35 USC 102(e), applicant has relied the foreign priority papers to overcome this rejection and has submitted a certified translation of said papers in accordance with 37 CFR 1.55 and thus has antedated the applied patent to Pelosi, Jr. et al. and this rejection has been withdrawn.

7. Applicant's arguments with respect to claim 17 have been considered but are moot in view of the new ground(s) of rejection. It is noted, however, that applicant's arguments directed to the issue that two tools are not disclosed by Mende are not persuasive since, as previously stated, the Examiner's position is that the use of two tools together is considered to be clearly a matter of intended use of a particular tool.

Art Unit: 3724

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

Communications via Internet e-mail regarding this application, other than those under 35 USC 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rinaldi.rada@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 USC 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cf
April 24, 2000